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VEDDER PRICE KAUFMAN

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## PATENT

09/695,493

AMENDMENT E (IN RESPONSE TO PAPER NO. 20051125  
(NON-FINAL OFFICE ACTION DATED 12/01/2005))

## REMARKS

An information disclosure statement was electronically submitted on 06/30/04. On 04/27/05, telephonic confirmation from Examiner Hussein El Chanti was received indicating that the references had been reviewed and that a signed paper by the Examiner would be forthcoming in the present Office action. No such paper was received in the previous two Office Actions mailed 05/12/2005 and 12/01/2005. Accordingly, Applicants' attorney sent an e-mail message to the Examiner on 12/21/2005 asking if an initialed copy of the Information Disclosure Statement would be forthcoming. In response thereto, the Examiner kindly telephoned Applicants' attorney indicating that an initialed copy would be mailed after Applicants' response to the present Office Action. Accordingly, Applicants' attorney respectfully reminds the Examiner to mail the signed paper in response to the present response.

Claims 1-36 are pending in this case. Claims 2, 14 and 26 have been amended to clarify what is meant by the word "it" in the aforementioned claims. Because the claims are believed to be merely amended as to form, they should be properly entered. Claims 13-14, 18-21 and 24 have also been amended to indicate that the computer readable program code causes one or more processors to function in the claimed manner. Claim 13 has been amended to indicate that the generated content is transmitted to the interface client for display. It is respectfully submitted that, among other places, support for the aforementioned amendments may be found on page 22, lines 1 – page 23, line 2 and page 2, lines 20-21, respectively.

Claims 1, 13 and 25 were rejected under 35 U.S.C. § 112 ¶ 2 as being indefinite for failing to point out and distinctly claim the subject matter which Applicants regard as the invention. According to the present Office Action, the claims "do not specify the device performing the steps of 'selecting interface clients', 'notifying the wireless device', 'executing an application' and 'transmitting an application.' It is unclear whether the above recited step are

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performed by the client device or the infrastructure server. (Office Action dated 12/01/2005, p. 2, ¶ 3).

This rejection is respectfully traversed as Applicants have fully complied with their statutory requirements found in the Patent Act. The MPEP provides that the "primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention . . ." MPEP § 2173.

The MPEP additionally states that the "essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." MPEP § 2173.02. Moreover, the Federal Circuit recently explained that the "requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles. . . Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366 (Fed. Cir. 2004); MPEP § 2173.02.

Turning first to the written description in the present application, it is respectfully submitted that the elements of claims 1, 13 and 25 are thoroughly described in definite terms to apprise the public of the metes and bounds of the patent while simultaneously providing notice of what Applicants contend is the invention. For purposes of example, Applicants' attorney draws the Examiner's

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attention to page 13, line 26 – page 14, line 9 which describes the methods of elements (b) and (d) of the claims. Similarly, Applicants' attorney draws the Examiner's attention to page 10, lines 5-14 which provides adequate definite language illustrating the method of element (c). Lastly, Applicants' attorney draws the Examiner's attention to page 14, lines 11-17 for a discussion on the methods of elements (e) and (f) of the claims. Applicants' attorney respectfully notes that the above citations are merely exemplary instances of where the above elements are discussed in the application and are not intended to limit the construction of the claims. That is, the above citations are not meant to provide the universe of resources necessary for a proper claim construction of the presently claimed subject matter.

Based on at least the aforementioned citations, it is respectfully submitted that the claim has a meaning discernible to one of ordinary skill in the art when construed according to correct principles of claim construction. Because the claim elements rejected under 35 U.S.C. § 112, ¶ 2 are anything but insolubly ambiguous after briefly turning to the written description, the claims cannot be said to be indefinite. This conclusion is only buttressed by the Examiner's ability to substantively reject the claims under 35 U.S.C. § 102. Accordingly, the rejection should be withdrawn.

Claims 2, 14 and 26 were rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action rejected the use of the term "it" in the aforementioned claims. As mentioned above, claims 2, 14 and 26 have been amended to properly delineate that each instance of the term is in reference to the "wireless device." Accordingly, Applicants' attorney respectfully requests the rejection to be withdrawn.

Claims 13-24 were rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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Applicants regard as the invention. This rejection is respectfully traversed as being a typographical error. This contention is supported by the following observations: (1) claims 13 and 14 were already rejected under the same section of the Patent Act as discussed above; (2) the claims appear to have the same or similar scope as claims 1-12 and claims 25-36 but are directed at a computer program product while claims 1-12 and 25-36 were not similarly rejected; and (3) there is no explanation for why the claims are viewed to be indefinite as provided with respect to rejected claims 1-2, 13-14 and 25-26<sup>1</sup>. Accordingly, Applicants' attorney respectfully requests the Office to withdraw the present rejection. If, however, the rejection is maintained, Applicants' attorney respectfully requests the Examiner to identify which elements are considered to be indefinite in view of 35 U.S.C. § 112, ¶ 2. Moreover, if maintained, Applicants' attorney additionally requests that the rejection with respect to these claims not be made final.

Claims 13-24 were rejected under 35 U.S.C. § 101 because the claimed invention is alleged to be directed to non-statutory subject matter. Citing MPEP § 2106 IV.B.2(b), the Office Action states that the claims "merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated." (Office Action dated 12/01/2005, p. 3, ¶ 8). This rejection is respectfully traversed. As indicated above, claims 13-14, 18-21 and 24 have been amended to indicate that the computer readable program code causes one or more processors to function in the claimed manner. Accordingly, it is respectfully submitted that Applicants are under no statutorily-imposed duty to claim the use of a computer. Additionally, claim 13 has been amended to indicate that the computer readable program code causes the one or more processors to transmit the

<sup>1</sup> See e.g., MPEP § 2173.02 ("If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action.").

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generated content to the interface client for display.

It is respectfully noted that the rejection was issued, at least in part, under an improper section of the MPEP. For instance, MPEP § 2106 IV.B.2(b) considers whether a process is directed toward statutory subject matter under 35 U.S.C. § 101 and does not, by itself, address whether an article of manufacture (i.e., Applicants' claimed computer program product) is directed toward statutory subject matter. Applicants' attorney respectfully notes that MPEP § 2106 IV.B2(a) governs the issue at hand. However, it is respectfully acknowledged that "for purposes of a 35 U.S.C. § 101 analysis, it is of little relevance whether the claim is directed to a machine or a process. The legal principles are the same." MPEP § 2106 IV.B2.

For instance, on the one hand, a "claim limited to a machine or manufacture which has a practical application in the technological arts, is statutory." MPEP § 2106 IV.B2(a). As held in the *State Street Bank & Trust Co. v. Signature Financial Group*, "the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces a useful, concrete and tangible result – a final share price momentarily fixed for recording and reporting purposes . . ." 149 F.3d 1368, 1373 (Fed Cir. 1998)(emphasis added).

Similarly, on the other hand, an article of manufacture that defines a functional and structural interrelationship between a computer usable medium and computer readable program code included therein is directed toward statutory subject matter when it is capable of implementing a statutory process. MPEP § 2106 IV.B1(b). A claimed process that results in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan or that is limited to a practical to a practical application with the technological arts constitutes statutory subject matter. *Id.* "A claim is limited to a practical

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application when the method, as claimed, produces a concrete, tangible, and useful result." MPEP § 2106 IV.B1(b)(ii)(emphasis added).

Because claim 13 is directed to, among other things, computer readable program code that, when executed by one or more processors, causes the transmission of generated content to the interface client for display, the article of manufacture is capable of producing a useful, concrete and tangible result. Similar to the holding in *State Street*, the computer readable program code, when executed, causes the display of generated content such that it is at least momentarily fixed for display purposes and may be accepted and relied upon by one or more users based on the context of the executed program. A practical application of the article of manufacture (and the process it is capable of implementing) has been demonstrated. Accordingly, it is respectfully submitted that the rejection of claims 13-24 under 35 U.S.C. § 101 be withdrawn.

Claims 1-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,421,716 to Eldridge et al. ("Eldridge"). This rejection is respectfully traversed; it is submitted that these claims recite subject matter that is not anticipated and is patentable over Eldridge.

Independent Claims 1, 13 and 25

The present action cites Eldridge, column 9, line 13 – column 10, line 26 as teaching each element of independent claims 1, 13 and 25. It is respectfully submitted that the Eldridge fails to teach or suggest the claimed subject matter expressly claimed. In fact, Eldridge expressly teaches away from the claimed subject matter by teaching an opposite flow of information with respect to at least elements (a) and (c), to the extent the claimed subject matter can be compared to the cited reference.

The above-cited reference to Eldridge appears to be directed to, among other things, a system for generating context-sensitive hierarchically ordered document service menus. In general, the hierarchical list is displayed at the mobile

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computing device and provides the user with immediate access to the queried document device as well as links to other devices that are ordered in a location and class specific hierarchy. (See Abstract). As taught by Eldridge, "a user beams a request for document services [presumably the query for document devices] to an IR gateway that is located near or is attached to a printer is automatically assigned a context by context insertion sliver 115." (Col. 8, lines 49-52; Fig. 4A, element 404). "Upon receipt of a request for available services," a plurality of servers interpret the request and "transmits to the network gateway . . . the list of available services that reflects the location-context information if available. (Id.; Fig. 4A, elements 408, 410, 412, 414). Upon receipt, the network gateway 114 and 120 communicate the information relating to available services to mobile computing device 118." (Col. 8, line 67 – Col. 9, line 12; Fig. 4A, element 416). "Once a list of available services is received at the mobile computing device 118, the 'Services Directory' screen 704 . . . is presented at user interface 500." (Col. 9, lines 12-15).

Thus, to the extent Eldridge can be compared to Applicants' claimed subject matter, the mobile computing device is provided information from the plurality of servers (i.e., the transaction server and directory server) regarding the list of available services. In contrast, it is respectfully noted that element (a) of claim 1 specifically requires, among other things, that an infrastructure server receives from a wireless device a list of usable interface clients in proximity to the wireless device. (Emphasis added).

Moreover, Eldridge further teaches that the "mobile computing device 118 transmits the request specified by the user in display screen 704" for transmission to the transaction server 144. (Col. 10, lines 39-46; Fig. 4A, elements 442, 446). Again, to the extent that the claimed subject matter can be compared to the cited reference, Eldridge expressly teaches that the mobile computing device instructs the server as to the selection of an available service. In contrast, the claimed subject matter in element (c) requires, among other things, that the wireless device

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is notified of the selected interface client. (Emphasis added).

In each instance discussed above, the transfer of information discussed in Eldridge is in the opposite direction as disclosed in Applicants' claim 1. Because Eldridge teaches away from the claimed subject matter, it is respectfully submitted that the reference cannot, by definition, anticipate Applicants' claim 1.

Accordingly, the rejection must be withdrawn.

For the aforementioned reasons, immediate allowance of claim 1 is earnestly solicited. Independent claims 13 and 25 are directed toward a computer program and system, respectively, for facilitating user interface roaming and contain the same or similar subject matter as that listed in claim 1. For the reasons disclosed hereinabove, claims 13 and 25 are submitted as allowable over Eldridge.

Dependent Claims 2-12, 14-24, 26-36

The applicable remarks above are respectfully restated and incorporated herein by reference with respect to dependent claims 2-12, 14-24 and 26-36. It is respectfully submitted that the aforementioned claims contain novel and otherwise non-obvious patentable subject matter not disclosed by Eldridge. Accordingly, claims 2-12, 14-24 and 26-36 are also in proper condition for allowance.

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Claims 1-36 remain pending in this case. Based upon the foregoing remarks, it is respectfully submitted that these claims are allowable, and reconsideration and early allowance of these claims are requested.

Respectfully submitted,  
VEDDER, PRICE, KAUFMAN & KAMMHLZ, P.C.

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